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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/865,774	05/25/2001	Timothy Wells	2620	5773

7590 03/03/2003

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EXAMINER

BAXTER, JESSICA R

ART UNIT PAPER NUMBER

3731

DATE MAILED: 03/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/865,774

Applicant(s) **MP**

WELLS ET AL.

Examiner

Jessica R Baxter

Art Unit

3731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12/18/2002 and 11/5/2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 December 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) Z. 6) ☐ Other: _____

DETAILED ACTION

Specification

1. The disclosure was objected to because of a typographical error. Correction is noted and the objection is withdrawn.

Drawings

2. The corrected or substitute drawings were received on December 18, 2002. These drawings are acceptable.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 1- 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,674,237 to Ott in view of U.S. Patent No. 5,928,154 to Silber et al. Ott discloses a trocar assembly comprising an obturator (see FIG. 2 obturator 22), a sharpened tip (see FIG. 2 tip 24), and a hand grip (see FIG.2 handle 110). Ott discloses the claimed invention except for the cushioned member positioned on at least one contact surface of the hand grip. Silber teaches that a cushioned member is provided on the hand grip in order to enable the instrument's user to maintain control while applying minimal gripping force (see Column 3 lines 17-23). Although Silber discloses that the member is substantially non compressible (see Column 3 lines 17-19), Silber later discloses that the material used would have a low durometer and thus has a cushioning effect (see Column 3 lines 63-64). In addition, the preferred materials of the claimed invention such as Santoprene, silicone, and

Art Unit: 3731

nitrile are specifically mentioned as being used to form the cushioned member (see Column 8 lines 28-60). It would have been obvious to one having ordinary skill in the art at the time the invention was made to add a cushioned member to the hand grip of Ott's trocar assembly in order to enable the instrument's user to maintain control of the instrument while applying minimal gripping force.

Regarding claim 2, Silber discloses that the cushioned member is made from a thermoplastic elastomer (see Column 3 lines 63-64).

Regarding claims 3 and 10, Silber discloses that the cushioned member is over-molded onto the hand grip (see Column 4 lines 26-27).

Regarding claim 4, Silber discloses that the cushioned portion is formed from an elastomeric material (see Column 8 lines 28-60).

Regarding claims 5 and 6, Silber does not specifically disclose that the cushioned member is secured to a hand grip with an adhesive or by welding. Silber does suggest that the cushioned member may be secured to the hand grip by other methods. Silber discloses that adhesives are not used to attach the cushioned member to the hand grip (see Column 3 lines 53-58). However, Silber does specifically suggest that adhesives are a known way of permanently attaching things together. Silber chooses not to utilize adhesives since he considers them not to be on the same level of secured attachment as the mechanical interlocking that he prefers. A person skilled in the art would be able to select and utilize adhesives if he desired a lower level of secured attachment. Silber also discloses that many other techniques may be used in the art to secure the cushioned member to the hand grip. Silber specifically suggests coating, laminating, molding, and casting procedures (see Column 8 lines 23-27). Welding is another well known attachment technique that is equivalent to any of the methods suggested by Silber. It would have been obvious to one having ordinary skill in

Art Unit: 3731

the art at the time the invention was made to secure the cushioned member to the hand grip since welding and applying adhesives are well known attachment techniques.

Regarding claim 7, Silber discloses that the cushioned member is formed from a slip-resistant material (see Column 3 lines 17-19).

Regarding claim 8, Silber discloses that the elastomeric material can be nitrile or silicon (see Column 8 lines 28-60).

Regarding claim 9, Ott discloses that the hand grip may be formed of a thermoplastic material (Column 5 lines 29-33) and Silber discloses that the cushioned member is formed from an elastomeric material (see Column 8 lines 28-60).

Response to Arguments

5. Applicant's arguments filed 12/18/2002 have been fully considered but they are not persuasive.

6. Applicant argues that the grip of Silber et al. '154 does not provide a cushioning effect since Silber specifically states that the grip layer is "substantially non-compressible." Although, Silber does state that the grip layer is substantially non-compressible, there is no indication that it cannot have a cushioning effect. The term "substantially" implies that it is going to compress a little and thus provide the cushioning effect of the claimed invention. In addition low durometer materials are specifically listed in Silber's specification (Column 8 lines 7-60). Low durometer materials will provide a cushioning effect since they are in the low ranges of material hardness. Therefore, the rejection of claims 1-10 over Ott '237 in view of Silber '154 is proper.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 3731

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jessica R Baxter whose telephone number is 703-305-4069. The examiner can normally be reached on M-F 8:30AM - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Milano can be reached on 703-308-2496. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3590 for regular communications and 703-305-3590 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.

Jessica R Baxter
Examiner
Art Unit 3731


JRB

February 24, 2003


MICHAEL J. MILANO
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700